

REMARKS

Claims 1, 7, 8, 12, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Albanese et al* (U.S. Patent 6,002,768) ("Albanese") in view of *Banker et al* (U.S. Patent No. 6,005,938) ("Banker"). Claims 9, 10, 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Albanese and Banker as applied to claims 1 and 12 above, and further in view of *Dillaway et al* (U.S. Patent 5,742,756) ("Dillaway"). Claims 11 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Albanese and *Lohstroh et al* (U.S. Patent 5,768,373) ("Lohstroh") as applied to claims 1 and 12 above, and further in view of *Kruys* (U.S. Patent 5,555,309) ("Kruys"). These rejections do not apply to the new and amended claims.

Claim 1 includes: A method for encrypting data, the method comprising: providing a first data processing system for a first user and a second data processing system for a second user; providing a session key randomly generated by the second system for use in encrypting original data; encrypting the data using the session key and a symmetric encryption routine; encrypting the session key with a public key of the first user using an asymmetric encryption routine for storage as a first user key blob; encrypting the session key with a master public key using an asymmetric encryption routine for storage as a master key blob; storing a first user private key on any media; decrypting the user key blob using the asymmetric encryption routine providing the first system with access to the session key; and the first system decrypting the data using the symmetric encryption routine and securely transmitting the data to the first system.

Furthermore, claim 12 includes: ... a third party gaining access to the data using a master private key to decrypt the master key blob using the asymmetric encryption routine and gain access to the original data.

Claim 30 includes a method for encrypting data comprising: providing a first data processing system for a first user and a second data processing system for a second user; the second user sending the first user a data file; the second system randomly generating a session key for use in encrypting original data in the data file; using the session key, the second system encrypting the data using a symmetric encryption routine; encrypting the session key, with a public key of the first user, using an asymmetric encryption routine for storage as a first

user key blob within the encrypted data; encrypting the session key with a master public key using an asymmetric encryption routine for storage as a master key blob within the encrypted data; transmitting the encrypted data to the first system; storing a first user private key on any media; decrypting the user key blob using the asymmetric encryption routine providing the first system with access to the randomly generated session key; the first system decrypting the data using the symmetric encryption routine and securely transmitting the data to the first system; and a third party gaining access to the data using a master private key to decrypt the master key blob using the asymmetric encryption routine and gain access to the original data.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the claimed recitations stated above.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests providing the claimed recitations stated above.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, the independent claims and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1, 7-12 and 18-22 and 30 is respectfully requested.

PATENT


Docket No.: 16356.722 (DC-01753)

Customer No.: 000027683

The amendments are fully supported by the original description and drawings.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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